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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,923	07/08/2003	Marie-Claire Grosjean-Cournoyer	A34658-PCT-USA-I (072667.	3094

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EXAMINER	
LAMBERTSON, DAVID A	

ART UNIT	PAPER NUMBER
1636	

DATE MAILED: 10/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/614,923	GROSJEAN-COURNOYER ET AL.	
	Examiner	Art Unit	
	David A. Lambertson	1636	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 09/937,236.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

SDD

DETAILED ACTION

Receipt is acknowledged of a preliminary amendment, filed July 8, 2003. Amendments were made to the claims. Specifically, claims 1-13 and 15-19 were cancelled.

Claim 14 is pending and under consideration in the instant application.

Information Disclosure Statement

The information disclosure statements filed October 10, 2003 and January 18, 2005 have been considered, and a signed and initialed copy of the form PTO-1449s are attached to this Office Action.

Specification

The disclosure is objected to because of the following informalities: the reference to US Application 09/937,236 in the first line of the specification requires an update to reflect the status of the case as US Patent 6,617,163.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,985,570 (IDS reference #21; see entire document; henceforth Amutan) in view of Hua-Van *et al.* (IDS reference #7; see entire document; henceforth Hua-Van).

Amutan teaches a process for using an *Aspergillus niger* (an asexual fungus) transposable element in methods of gene tagging, wherein the transposable element is used to inactivate a gene (see for example column 3, lines 55-61). This method has an advantage in that the gene corresponding to the disruption mutants can then be identified and associated with a phenotype (see for example column 8, lines 30-49). In a specific example (see for example column 15, Example 7), Amutan teaches the use of the gene tagging process for identifying genes that, when inactivated by insertion of a transposon, have an effect on halo formation (a phenotype associated with limited foreign protein production, thereby allowing the identification of genes involved in heterologous protein production). In this method, insertion mutants are prepared by transforming fungi with a transposable element, a phenotype is selected for, and mutants are identified by locating the transposon insertion (see for example, again, Example 7). Although Amutan clearly teaches a method of identifying genes in fungi that are associated with a phenotype by inserting a transposon into a gene, detecting a phenotype, and isolating the gene that is mutated by the transposon, Amutan does not teach the use of the *Impala* transposon, specifically.

Hua-Van teaches the identification of a new member of a transposon superfamily, the fungal *Impala* transposable element (see for example the Abstract and page 355-356). Hua-Van further teaches that the *Impala* transposon could be a powerful tool for tagging genes in fungi

without a sexual cycle because gene isolation in those fungi are very difficult (see for example page 361).

It would be obvious for the ordinary skilled artisan to combine the teachings of Amutan with the teachings of Hua-Van to utilize the *Impala* transposon as a gene tagging device in fungi because both teachings involve fungal transposons, and their appearance in asexual fungal species. Furthermore, Amutan clearly teaches a method of using a fungal transposon as a gene tagging mechanism in asexual fungi. Since Amutan teaches a method of identifying genes associated with certain phenotypes by using fungal transposable element, and Hua-Van specifically teaches that the *Impala* fungal transposable element would be a useful and powerful tool for identifying genes in asexual fungi via gene tagging methods, the ordinary skilled artisan would have been clearly motivated to combine the references. Absent evidence to the contrary, the ordinary skilled artisan would have had a reasonable expectation of success when combining the teachings of Amutan and Hua-Van to arrive at the instantly claimed invention.

Allowable Subject Matter

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (571) 272-0771. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (571) 272-0781. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David A. Lambertson, Ph.D.
AU 1636

JAMES KETTER
PRIMARY EXAMINER